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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,219	01/21/2004	Kia Silverbrook	SMA04US	1368
24011 7590 10/15/2008 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER				
UHLENHAKE, JASON S				
ART UNIT		PAPER NUMBER		
2853				
MAIL DATE		DELIVERY MODE		
10/15/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/760,219

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

JASON S. UHLENHAKE

**Art Unit**

2853

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2-16 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 2-16, 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/5/2008.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 recites the limitation "the carrier" in line 3 and line 4 of claim 20. There is insufficient antecedent basis for this limitation in the claim. It is not clear to the Examiner what the carrier is referring too (frame, support etc...). Appropriate correction is required.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: In claim 1, the expression "having a digital processor and a printer arranged to receive drive signals from the digital processor" is unclear to the Examiner what is being claimed. The abstract and specification would suggest that the applicant is claiming a cartridge as their invention; however as claim 1 is currently written, it appears that the applicant is trying to claim a digital processor and a printer as being a part of the cartridge, and/or it appears that the applicant is trying to set forth a digital processor and printer as

limitations of the cartridge. The Examiner would suggest clarifying the claim language as "A cartridge for a digital photofinishing system, the digital photofinishing system having a digital processor..." (emphasis added). Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 19, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (U.S. Pub. 2002/0093569) in view of Enix (U.S. Pat. 4,904,100).

***Silverbrook discloses:***

- ***regarding claim 1***, a cartridge (504) for a digital photofinishing system (Abstract; Paragraphs 0005-0008) having a digital processor and a printer arranged to receive drive signals from the digital processor (Paragraphs 005, 0061-0065); the cartridge (504) being arranged to be mounted removably in juxtaposition to the printer (Figures 12-13) and comprising a replaceable roll of print media and a replaceable source of printing fluid (548), both of which are arranged to be delivered on demand to the printer (Abstract)
- print media feed means arranged to couple with drive means of the digital photofinishing system (Paragraphs 0040-0041)

- **regarding claim 21**, wherein the print media feed means include a drive roller and a pinch roller (534, 536), wherein the drive means comprises a drive motor (Paragraphs 0040-0042)

***Silverbrook does not disclose expressly the following:***

- **regarding claim 1**, an opening arranged to enable a roller of the digital photofinishing system to contact the roll of print media; wherein the print media is fed through the printer by operation of the roller on the roll of print media and the coupled drive and print media feed means

- **regarding claim 19**, wherein a door is provided in a wall portion of the cartridge and wherein the door is arranged to be opened to enable the roller to engage the roll of print media

***Enix discloses:***

- **regarding claim 1**, an opening arranged to enable a roller (27) of the digital photofinishing system to contact the roll of print media (Figures 1-2; Column 3, Lines 39-52); wherein the print media is fed through the printer by operation of the roller on the roll of print media and the coupled drive and print media feed means (Figures 5-6; Column 2, Line 66 – Column 3, Line 21)

- **regarding claim 19**, wherein a door is provided in a wall portion of the cartridge and wherein the door is arranged to be opened to enable the roller to engage the roll of print media (Figures 1-2; Column 3, Lines 39-52)

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to include an opening and a roller to move/engage the media of

the cartridge, as taught by Enix, into the device of Silverbrook, for the purpose of providing access to the internal media of a cartridge and guiding media input.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (U.S. Pub. 2002/0093569) as modified by Enix (U.S. Pat. 4,904,100) as applied to claim 1 above, and further in view of Driggers (U.S. Pub. 2003/0076397)

***Silverbrook as modified by Enix discloses:***

- ***regarding claim 20***, a roller (27) arranged to engage the roll of print media when the door in the cartridge is open, and a second drive motor (12) arranged to impart rotary drive to the roller (Figures 5-6; Column 2, Line 66 – Column 3, Line 21; Figures 1-2; Column 3, Lines 39-52)

***Silverbrook as modified by Enix does not disclose expressly the following:***

- ***regarding claim 20***, a paper feed drive mechanism which comprises a pivotal carrier, a first drive motor arranged to impart pivotal drive to the carrier

***Driggers discloses:***

- ***regarding claim 20***, a paper feed drive mechanism which comprises a pivotal carrier, a first drive motor arranged to impart pivotal drive to the carrier (Paragraphs 0029, 0035)

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate a pivotal carrier controlled by an electrical motor in order to convey media as taught by Driggers into the device of Silverbrook as modified

by Enix, for the purpose of selectively engaging the members of the print media  
(Paragraph 0029)

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JASON S. UHLENHAK** whose telephone number is (571)272-5916. The examiner can normally be reached on Monday-Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JASON S UHLENHAKES/  
Examiner, Art Unit 2853  
September 30, 2008

/Julian D. Huffman/  
Primary Examiner, Art Unit 2853